# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/893,465 | 06/29/2001 | Dominique Gougeon | 10015737-1 | 5281 |

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| EXAMINER |
|---|
| NALVEN, ANDREW L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2134 | |

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

    b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

        Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

        NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: _____.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.
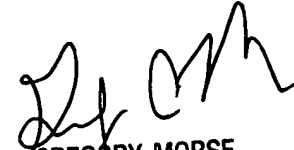
<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. Applicant has alleged that the Veil patent, US Patent No. 6,092,202, fails to teach "the smartcard including an embedded secure processor programmed to perform all digital signing operations that require access to the private key." Applicant has asserted that instead Veil teaches a filing signing tool external to the smart card performing all digital signing operations that require access to a private key. Examiner respectfully disagrees with these assertions. Veil teaches the smartcard including an embedded secure processor programmed to perform all digital signing operations that require access to the private key (Veil, column 11 lines 45-52, column 6 lines 8-11) by teaching a smart card that receives a hash value and then encrypts the received hash value with the private key stored within the smart card. Once the encryption of the hash value has been completed, the smart card sends the digitally signed hash value to the secure computing environment. The encrypting of the hash value is the only digital signing operation that requires access to the private key and thus the smart card of Veil teaches the above-cited claim limitation because the smart card itself performs this function. All other required actions, including the hashing of a message or file, do not require the use of the private key. Thus, Examiner maintains the that Veil teaches the above-cited limitation.

Further, Examiner notes that contrary to Applicant's assertion, the private key is not released from the smart card. Veil specifically states "for reasons rooted in common security practice, private keys should never come off the smart cards" (Veil, column 11 lines 47-50).

Applicant has further alleged that Veil teaches away from the present invention by suggesting that Veil dismisses the possibility of having a smart card perform all security functions on the grounds of cost and smart card size constraints (Applicant cites Veil, column 1 line 66 - column 2 line 8) . Examiner respectfully disagrees with this assertion. Examiner notes that as currently claimed, the present invention does not require all security functions to be performed by the smart card, instead the present claims require that only operations requiring the private key be performed by the smart card. The cited portion of Veil provides the reasoning behind Veil's decision to only require the smart card to perform functions requiring the private key. A smart card, according to Veil, would be an inefficient in terms of cost at performing the functions delegated to Veil's secure computing environment. Thus, Veil only requires the smart card to perform private key related functions.

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